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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,108	09/29/2003	Thomas R. Goecke	5923.0001	2438

86625 7590 04/06/2011  
Brennan, Manna & Diamond, LLC  
The Carnegie Building  
75 East Market Street  
Akron, OH 44308

EXAMINER
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NORDMEYER, PATRICIA L

ART UNIT	PAPER NUMBER
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1788

NOTIFICATION DATE	DELIVERY MODE
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04/06/2011

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/674,108	<b>Applicant(s)</b> GOECKE, THOMAS R.	
	<b>Examiner</b> PATRICIA L. NORDMEYER	<b>Art Unit</b> 1788	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 February 2011.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 and 9-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### **Repeated Rejections**

1. The 35 U.S.C. 102(b) of claim 12 as being anticipated by DeRusha et al. (USPN 4,484,574) in the office action dated August 23, 2010 is repeated as Applicant's arguments in the response dated February 23, 2011 are found to be unpersuasive. The rejection is repeated below for Applicant's convenience.

DeRusha et al. discloses an adhesive tape (Abstract) comprising: a polymer layer having a thickness between 0.031" and 0.236" (Column 2, lines 14 – 23), the polymer layer defining a first side (Figure 1, #16); and a double sided adhesive layer where one side of the double sided adhesive layer<sup>1</sup> is in substantially continuous contact with the first side of the polymer layer (Figure 1, #12) and an opposing side of the double sided adhesive layer is disposed to adhere to the flooring environment (Column 3, lines 28 – 52; Figure 1, #12, wherein the adhesive can attach to any substrate surface, Column 5, lines 1 - 5); where the adhesive tape has a peel adhesion of 250 g/cm to 850 g/cm width, which meets the limitation of a peel adhesion greater than 2.0 lb/in width (2.0 lb/in width converts to 357 g/cm width) (Column 3, lines 41 – 52) as in claim 12.

As to the limitation of "adhesive layer is disposed to adhere to the flooring environment", the term disposed, as defined by Merriam-Webster's, means "to give a tendency

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<sup>1</sup> The Examiner notes that any layer of adhesive has two sides, each side having adhesive properties. Therefore, the reference's disclosure of a layer of adhesive anticipates the claim limitation of a double sided adhesive layer.

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to". Since the adhesive tape of DeRusha et al. meets the claim limitations, it would be capable of, or disposed to, adhere to a flooring environment.

2. The 35 U.S.C. 103(a) of claims 1 - 3, 5, 7, 9 and 10 over Jonhston et al. (USPN 3,895,153) in the office action dated August 23, 2010 is repeated as Applicant's arguments in the response dated February 23, 2011 are found to be unpersuasive. The rejection is repeated below for Applicant's convenience.

As to claim 1, Johnston et al. discloses an adhesive article that can be formed into any shape, (Abstract; Column 8, lines 16 - 20) comprising a polymer layer having a Shore A Hardness of between about 60 and 95 (Figure 4, #18; Column 4, lines 51 - 55) and a substantially uniform thickness of 10 to 60 mils or 0.010" to 0.060" (Figure 4, #18; Column 5, lines 48 - 52); and a layer of adhesive attached to said polymer layer (Figure 6, #38).

Johnston et al. differs from claim 1 in two ways. First, Johnston et al. fails to disclose an anticipatory example, or ranges that are sufficiently specific to anticipate the ranges of Shore A Hardness, polymer layer thickness (claim 1). However, Johnson et al. teaches a range of Shore A Hardness of between about 60 and 95 (Column 4, lines 51-55) which overlaps the claim 1 range of between about 92 and 100. Johnston et al. teaches a polymer layer thickness of 0.010 to 0.060" which overlaps the claim 1 range of between about 0.020 and 0.065". Overlapping ranges have been held to establish prima facie obviousness. See MPEP 2144.05.

Therefore, it would have been obvious to one of ordinary skill in the art to have selected from the overlapping portion of the ranges of Shore A Hardness and thickness taught by Johnston et al. because overlapping ranges have been held to establish prima facie obviousness.

Second, Johnson et al. fail to specifically refer to its article as being an “adhesive tape.” Johnston et al. teaches that the article can be formed into any shape, (Abstract; Column 8, lines 16 - 20). The term “tape,” as defined by Merriam-Webster’s, means “a narrow flexible strip or band.” And, it is well settled that a particular shape of a prior invention carries no patentable weight unless the applicant can demonstrate that the new shape provides significant unforeseen improvements to the invention. In the instant case, the application does not indicate any new, significant attributes of the invention due to its shape which would have been unforeseen to one of ordinary skill in the art.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to change the shape to change the shape of the adhesive article to be in the form of a narrow strip or band. One skilled in the art would have been motivated to do so in order to change the appearance of the adhesive article. MPEP 2144.04 IV.

With regard to claim 2, the article contains a substrate attached to an outermost side of said layer of adhesive (Figure 6, # 39).

For claim 3, the polymer layer includes a textured surface (Figure 4, #18).

Regarding claim 5, the polymer layer includes coloring pigment (Column 5, lines 38 – 48).

As in claim 7, the adhesive comprises a rubberized double-sided tape (Column 3, lines 43 – 49, since the adhesive has adhesive qualities on the opposite sides of the layer, it reads upon a double side adhesive product).

With regard to claim 9, polymer layer has a Shore A Hardness of between about 60 and 95, thereby meeting the limitation of a Shore A Hardness of 93 and 97 (Column 4, lines 51 – 55).

For claim 10, the adhesive is pressure sensitive (Column 5, lines 67 – 69).

3. The 35 U.S.C. 103(a) of claim 12 over Hornibrook et al. (USPN 4,248,762) in the office action dated August 23, 2010 is repeated as Applicant's arguments in the response dated February 23, 2011 are found to be unpersuasive. The rejection is repeated below for Applicant's convenience.

Hornibrook et al. disclose a pressure sensitive product (Column 1, lines 10 – 13) comprising: a polymer layer having a thickness between 0.002" and 0.020", thereby overlapping the thickness limitation of 0.020" and 0.065" (Column 2, lines 1 – 15), the polymer layer defining a first side (Figure 1, #1); and a double sided adhesive layer where one side of the double sided adhesive layer is in substantially continuous contact with the first side of the polymer layer (Column 2, lines 16 – 39; Figure 2, #2) and an opposing side of the double sided adhesive layer is disposed to adhere to the flooring environment (Column 2, lines 16 – 39; Figure 2, #2); where the adhesive tape has a peel adhesion of 7.5 pounds per linear inch, which meets the limitations of a peel adhesion greater than 2.0 lb/in width (Column 5, lines 1 – 3) as in claim 12.

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Hornibrook et al. differs from claim 12 in two ways. First, Hornibrook et al. fails to disclose an anticipatory example, or ranges that are sufficiently specific to anticipate the claim 12 range of thickness of 0.020 to 0.065". However, Hornibrook et al. teaches a range of thickness of 0.002" and 0.020" (Column 2, lines 1 – 15), which overlaps the claim 12 range of between 0.020 and 0.065". Overlapping ranges have been held to establish prima facie obviousness. See MPEP 2144.05.

Therefore, it would have been obvious to one of ordinary skill in the art to have selected from the overlapping portion of the ranges of Shore A Hardness taught by Reeves et al. because overlapping ranges have been held to establish prima facie obviousness.

Second, Hornibrook et al. fail to disclose that the adhesive article is specifically an adhesive tape.

The term tape, as defined by Merriam-Webster's, means "a narrow flexible strip or band". It is well settled that a particular shape of a prior invention carries no patentable weight unless the applicant can demonstrate that the new shape provides significant unforeseen improvements to the invention. In the instant case, the application does not indicate any new, significant attributes of the invention due to its shape which would have been unforeseen to one of ordinary skill in the art.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to change the shape of the adhesive article to be in the form of a narrow strip or band. One skilled in the art would have been motivated to do so in order to change the appearance of the adhesive article. MPEP 2144.04 IV.

As to the limitation of “adhesive layer is disposed to adhere to the flooring environment”, the term disposed, as defined by Merriam-Webster’s, means “to give a tendency to”. Since the adhesive product of Hornibrook et al. meets the claim limitations, it would be capable of, or disposed to, adhere to a flooring environment.

### **Withdrawn Rejections**

4. Any rejections and or objections, made in the previous Office Action, and not repeated above, are hereby withdrawn due to Applicant’s arguments in the response dated February 23, 2011.

### **Claim Rejections - 35 USC § 103**

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1 – 6, 9 - 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reeves et al. (USPN 5,508,084) in view of Goswami et al. (USPN 4,343,856).

As to claim 1, Reeves et al. discloses a repositionable article that can be cut into any shape, (Column 7, lines 34 – 36) comprising a polymer layer (Figure 2d, #19; Column 10, lines 21 – 29) having a Shore A Hardness of between about 70 and 140 (Column 14, lines 25 – 29) and a substantially uniform thickness of between about 0.020" to 0.065" (Column 10, lines 30 –



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35) and a layer of adhesive attached to said polymer layer (Figure 2d, #13; Column 12, lines 30 – 44).

As to claim 11, Reeves et al. also a repositionable article that can be cut into any shape, (Column 7, lines 34 – 36) comprising: a polymer layer having a Shore A Hardness of between about 70 and 140 (Column 14, lines 25 – 29); and a layer of pressure sensitive adhesive comprising a first side and an opposed second side (Column 16, lines 43 - 54), the first side being in direct and uninterrupted contact with the polymer layer (Figure 2d) where the adhesive tape comprises an average thickness between 3 and 350 mils, since the backing sheet has a thickness of 2 to 100 mils (Column 4, lines 29 – 31) in combination with the adhesive layer having a thickness of 1 to 250 mils (Column 11, lines 4 - 16).

Reeves et al. differs from claims 1 and 11 in two ways. First, Reeves et al. fails to disclose an anticipatory example, or ranges that are sufficiently specific to anticipate the claim 1 range of Shore A Hardness and or overall tape thickness (claim 11). However, Reeves et al. teaches polyvinyl chloride layer (Column 14, lines 10 - 12) having a range of Shore A Hardness of between about 70 and 140 (Column 14, lines 25 – 29) which overlaps the claim 1 range. Goswami et al. teach that a polyvinyl chloride layer has a Shore A Hardness of 80 to 95 (Column 2, lines 3 - 21), which overlaps the claim 1 range. Reeves et al teaches a film thickness of 2 mils to 100 mils (Column 10, lines 31 - 35), wherein the adhesive contains microspheres with diameters of 1 to 250 micrometers which protrude from the adhesive layer (Column 11, lines 4 - 16), which would overlap the range of 65 to 69 mils. Overlapping ranges have been held to establish prima facie obviousness. See MPEP 2144.05.

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Therefore, it would have been obvious to one of ordinary skill in the art to have selected from the overlapping portion of the ranges of Shore A Hardness taught by Reeves et al. and shown by Goswami et al. because overlapping ranges have been held to establish prima facie obviousness.

Second, Reeves et al. fails to specifically refer to its article as being an “adhesive tape.” Reeves et al. teaches that the article can be formed into any shape, (Column 7, lines 34 – 36). The term “tape,” as defined by Merriam-Webster’s, means “a narrow flexible strip or band.” It is well settled that a particular shape of a prior invention carries no patentable weight unless the applicant can demonstrate that the new shape provides significant unforeseen improvements to the invention. In the instant case, the application does not indicate any new, significant attributes of the invention due to its shape which would have been unforeseen to one of ordinary skill in the art.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to change the shape to change the shape of the adhesive article to be in the form of a narrow strip or band. One skilled in the art would have been motivated to do so in order to change the appearance of the adhesive article. MPEP 2144.04 IV.

With regard to claim 2, the article contains a substrate attached to an outermost side of said layer of adhesive (Column 13, lines 10 – 15).

For claim 3, the polymer layer includes a textured surface (Figure 2d; Column 12, lines 16 - 23).

With regard to claim 4, the polymer layer is comprised of a polyvinyl chloride (Column 13, lines 28 – 36).

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Regarding claim 5, the polymer layer includes coloring pigment (Column 12, lines 25 – 31).

As in claim 6, the polyvinyl chloride comprises a clear polymer (Column 12, lines 25 – 31).

With regard to claim 9, polymer layer has a Shore A Hardness of between about 70 and 140, which overlaps the limitation of a Shore A Hardness of 93 and 97 (Column 14, lines 25 – 29).

For claim 10, the adhesive is pressure sensitive (Column 8, lines 9 – 13). However, Reeves et al. fail to disclose that the adhesive article is specifically an adhesive tape.

7. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hornibrook et al. (USPN 4,248,762).

Hornibrook et al. disclose a pressure sensitive product (Column 1, lines 10 – 13) comprising: a polymer layer having a thickness between 0.002" and 0.020", thereby overlapping the thickness limitation of 0.020" and 0.065" (Column 2, lines 1 – 15), the polymer layer defining a first side (Figure 1, #1); and a double sided adhesive layer where one side of the double sided adhesive layer is in substantially continuous contact with the first side of the polymer layer (Column 2, lines 16 – 39; Figure 2, #2) and an opposing side of the double sided adhesive layer is disposed to adhere to the flooring environment (Column 2, lines 16 – 39; Figure 2, #2); where the adhesive tape has a peel adhesion of 7.5 pounds per linear inch, which meets the limitations of a peel adhesion greater than 2.0 lb/in width (Column 5, lines 1 – 3). However,

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Hornibrook et al. fail to disclose the peel adhesion is measured under a test method including peeling the tape at a 90 degree angle after application to a stainless steel panel.

With regard to the limitation of disclose the peel adhesion is measured under a test method including peeling the tape at a 90 degree angle after application to a stainless steel panel, Hornibrook et al. disclose where the adhesive tape has a peel adhesion of 7.5 pounds per linear inch, which meets the limitations of a peel adhesion greater than 2.0 lb/in width (Column 5, lines 1 – 3). Since Hornibrook et al. disclose the adhesive product made of the desired materials with the specific dimensions, it would be obvious to one having ordinary skill in the art that the adhesive product would meet the peel adhesion when peeling the tape at a 90 degree angle after application to a stainless steel panel.

8. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johnston et al. (USPN 3,895,153).

Johnston et al. discloses an adhesive article that can be formed into any shape, (Abstract; Column 8, lines 16 - 20) comprising a polymer layer having a Shore A Hardness of between about 60 and 95 (Figure 4, #18; Column 4, lines 51 – 55) and a substantially uniform thickness of 10 to 60 mils or 0.010" to 0.060" (Figure 4, #18; Column 5, lines 48 – 52); and a layer of adhesive attached to said polymer layer (Figure 6, #38). However, Johnston et al. fail to disclose the adhesive tape comprises a peel adhesion greater than 2.0 lb/in width when peeled at a 90

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degree angle under a modified PSTC-101 method where the modified PSTC'101 method comprises a dwell time of one hour.

With regard to the limitation of disclose the peel adhesion is measured under a test method including peeling the tape at a 90 degree angle after application to a stainless steel panel, Johnston et al. disclose the adhesive product made of the desired materials with the specific dimensions, it would be obvious to one having ordinary skill in the art that the adhesive product would meet the peel adhesion when peeling the tape at a 90 degree angle after application to a stainless steel panel.

#### **Declaration under 37 C.F.R. 1.132**

9. The declaration under 37 CFR 1.132 filed February 23, 2011 is insufficient to overcome the rejection of claims 1 - 7 and 9 - 12 based upon the 102(b) and 103(a) rejections as set forth in the last Office action because: The applicant has provided no clear evidence that the references are obvious rejections over the claimed invention.

10. In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

#### **Response to Arguments**

11. Applicant's arguments filed February 23, 2011 have been fully considered but they are not persuasive.

Applicant's arguments with regard to the 112 1<sup>st</sup> and 2nd paragraph are moot since the rejections have been withdrawn.

With regard to Applicant's arguments that DeRusha fails to disclose its tape on "a flooring environment", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The structure of DeRusha is capable of adhering to a floor, thereby meeting the claimed limitation.

With regard to Applicant's argument that Johnston et al. fail to disclose the adhesive layer attached to the polymer layer with regard to claim 1, the claim language does not state that the adhesive layer has to be in direct contact with the polymer layer with no layers in between the polymer and adhesive. The open language of the claim, i.e. comprising, allows for layers to be in between the adhesive and the polymer layer. Therefore, Johnston et al. discloses the claimed adhesive tape.

With regard to Applicant's argument that Johnston et al. fail to disclose the pressure sensitive adhesive being in direct and uninterrupted contact with the polymer layer, please see the new rejection in view of Reeves et al.

With regard to Reeves failing to disclose the Shore A hardness range, please see the new rejection of Reeves in view of Goswami et al.

With regard to Applicant's arguments that Hornibrook fails to disclose its tape on "a flooring environment", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The structure of Hornibrook is capable of adhering to a floor, thereby meeting the claimed limitation.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PATRICIA L. NORDMEYER whose telephone number is (571)272-1496. The examiner can normally be reached on Mon.-Fri. from 10:00-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alicia Chevalier can be reached on (571) 272-1490. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Patricia L. Nordmeyer  
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